THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. MCLAUGHLIN, JOHN M. ANDERSON
and ERIC T. MCADAMS

Appeal No. 97-2739
Application 08/210,757[1]

ON BRIEF

Before CALVERT, LYDDANE and FRANKFORT, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1, 5 and 7. Claims 2 through 4, 6, 8 and 9, which are the only other claims pending in the application, stand withdrawn from further consideration by the examiner

[1] Application for patent filed March 22, 1994.

pursuant to the provisions of 37 CFR § 1.142(b) as being drawn to nonelected species of the invention.

The subject matter on appeal is directed to a biosignal electrode device. Claim 1 is exemplary of the invention and reads as follows:

1. A biosignal electrode device, comprising:

a) a flexible, electrically insulating substrate, and

b) an electrically conductive layer deposited on a surface of said substrate, and forming thereon an electrode sensor for contacting a patient's skin, and a lead for the sensor,

c) wherein a portion of the substrate bearing the sensor is formed in relief such that said substrate portion and attendantly the sensor are upstanding from surrounding substrate.

The references of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103 are:

Howson	4,082,087	Apr. 4, 1978
Ding et al. (Ding)	5,058,589	Oct. 22, 1991

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Ding.

Claims 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ding in view of Howson.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellants, we refer to pages 2 through 4 of the examiner's answer, to pages 4 through 6 of the appellants' brief and to the reply brief for the full exposition thereof.

OPINION

At the outset, we note that appellants have chosen not to argue the patentability of dependent claims 5 and 7 with any reasonable specificity. Accordingly, these claims stand or fall with the claims from which they depend. See In re Nielson, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526 (Fed. Cir. 1987). We note that 37 CFR § 1.192(c)(8)(iv) requires that the argument specify the errors in the rejection including any specific limitations in the rejected claims which are not described in the prior art relied on. Merely including the dependent claims along with arguments directed to a claim or claims from which they depend is not sufficient.

In arriving at our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art, and to the respective positions advanced by the appellants and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the

evidence adduced by the examiner is insufficient to establish an anticipation of appealed claim 1 under 35 U.S.C. § 102(b) or a prima facie case of obviousness with respect to appealed claims 5 and 7. Our reasoning for this determination follows.

We initially observe that an anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Additionally, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue); SRI Int'l v. Matsushita Elec. Corp. Of Am., 775 F.2d 1107, 1118, 227 USPQ 577, 583 (Fed. Cir. 1985). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject

matter or recognition of properties that are inherently possessed by the reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). Also, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. See In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S.Ct. 1362 (1996), quoting from In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

With this as background, we turn to the rejection of appealed claim 1 under § 102(b) as being anticipated by Ding. The patent to Ding discloses a biosignal electrode device in Figures 1 through 4 that includes an electrically conductive layer 1 having a sensor 9, 9' and a lead 5 for the sensor. Central to the appellants' position is the argument that even if one were to consider the portion of the conductive layer 1 of Ding that bears the sensor 9, 9' to be upstanding, that portion "is not upstanding from surrounding substrate" (reply brief, page 2) as required by appealed claim 1, but instead "is formed adjacent to the remainder of the substrate" (reply brief, page 2). Appellants have also cited a common dictionary definition of

the term "surround" which is "to cause to be encircled on all or nearly all sides" (reply brief, page 2).

The examiner has not provided any response or cogent line of reasoning disputing the appellants' position. Moreover, we agree entirely with the appellants' position as expressed above, that the substrate portion is not "upstanding from surrounding substrate" in the manner recited in appealed claim 1, and we conclude that the biosignal electrode of Ding fails to include every element recited in appealed claim 1. Thus, we cannot sustain the examiner's rejection of appealed claim 1 under 35 U.S.C. § 102(b). Furthermore, we also find nothing in the patent to Howson applied in the rejection of appealed claims 5 and 7 under § 103 which would supply the deficiencies of Ding noted above. Therefore, we also cannot sustain the examiner's rejection of these claims under 35 U.S.C. § 103.

Accordingly, the decision of the examiner rejecting claim 1 under 35 U.S.C. § 102(b) and rejecting claims 5 and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

Ian A. Calvert Administrative Patent Judge	)	
William E. Lyddane Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Charles E. Frankfort Administrative Patent Judge	)	

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